

Applicant: Herbert Wehler  
Application No.: 10/571,880

## **Remarks**

Claims 1 and 14 to 22 are pending in the application and were rejected. The drawings have also been objected to for not illustrating a carrier as recited in claim 1. As explained below, revised Figs. 1 to 3 now include a “carrier.”

Applicant also acknowledges that the June 30, 2010 Information Disclosure Statement was made of record, although it was not expressly mentioned in the action. A November 22, 2010 Information Disclosure Statement and a December 20, 2010 Information Disclosure Statement were indicated on the Office Action Summary, but it is noted that these are actually the June 30, 2010 Information Disclosure Statement.

## **AMENDMENTS**

### **Drawings**

Figs. 1 to 3 are amended herein to illustrate the “carrier 8” recited in independent claims 1 and 27. The carrier is specified in paragraph 29 of the specification, so no new matter is added.

### **Claims**

Claims 1 and 22 are amended to recite that the first end of the energy guide chain is connected directly to the carrier for movement with the sliding door. This amendment is supported by the disclosure in paragraph 31 of the published application, so no new matter is added.

Claim 22 is also amended to recite that the energy guide chain region bends in a single direction. The amendment matches the amendment to claim 1 in Applicant’s November 22, 2010 Amendment. This amendment is supported by all the drawings, so no new matter is added.

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### **Anticipation Rejection**

Only claim 22 was rejected under 35 U.S.C. §102(e) as being anticipated by *Kobayashi et al.*, U.S. Publication No. 2004/0003543 (copy enclosed). Applicants hereby amend claim 22 to include “bends in a single direction,” as was done in claim 1 in Applicant’s December 20, 2010 response. It is respectfully submitted that this amendment traverses the anticipation rejection.

### **Obviousness Rejection**

Claims 1, 14, 15, 16, 17, 18 and 19 to 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Murofushi et al.* U.S. Patent 6,492,592 in view of *Suzuki*, U.S. Patent 6,787,702. *Murofushi et al.* is a new reference, and the action asserts that item 39 of Fig. 2 is an energy guide 39. This “guide” is actually a coil spring that maintains a bent shape, but does not move with the sliding door (col. 6, lines 50 to 56, Figs. 1, 5, and 6, for example). The examiner acknowledges that the energy guide 39 is not a chain, but asserts that one skilled in the art would have known to replace the spring with an energy guide chain of *Suzuki* (action, p. 6). There is no citation to the art of record that such a change would have been known to one skilled in the art.

The legal standard for an obviousness rejection has not been met because, for example, there is no indication in the art of record that one skilled in the art would reasonably expect success in combining *Murofushi et al.* and *Suzuki* to arrive at the claimed invention. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The action has simply combined parts from different systems using the teaching of the present application. This is improper and does not provide a *prima facie* basis for an obviousness rejection. *In re Murray*, 268 F. 2d 226, 46 CCPA 905.

Indeed, if one skilled in the art were to combine the spring of *Murofushi et al.* and the chain of *Suzuki*, the only outcome taught by the references is that the chain would bend just as it

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does in *Suzuki*, since nothing in either patent explains how the coil spring would bend in only one direction as the sliding door moves.

Also, as shown at Figs. 7 and 8 of *Murofushi et al.*, the coil spring (39) and the bent portion (38) do not follow the movement of the sliding door. *Suzuki*'s chain does not bend in the manner recited in the claims and the spring of *Murofushi et al.* is not a chain that bends in only one direction. Thus, the claims would not have been obvious to one of ordinary skill in the art.

## Conclusion

For the foregoing reasons, Applicant respectfully submits that the pending claims are allowable and request that this case be passed to issue.

Respectfully submitted,

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